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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,161	06/25/2004	Shin-ya Matsunaga	1155-0279PUS1	7426

2292 7590 11/29/2007
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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11/29/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/500,161

Applicant(s)

MATSUNAGA ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/26/07 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16,17 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16,17 and 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed September 26, 2007 has been entered. Claims 1-15 and 18-21 are deleted. Claims 16-17 are amended. Now, Claims 16-17 and 22-27 are pending.
2. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC § 102 and 103

3. Rejection of Claims 16-17, 22 and 24 under 35 USC 102(b) as being anticipated by Hakuta407 (WO 01/98407, US 6 743 862), rejection of 23 and 25 under 35 USC 103(a) as being unpatentable over Hakuta407, optionally in view of Kakuta251 (WO 00/55251, US 6 864 315) and rejection of 26-27 under 35 USC 103(a) as being unpatentable over Hakuta407 in view of Kakuta251 are maintained because the rejection is adequately set forth in paragraph 3 of Paper No. 062307.

Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

The following column and line numbers are based on Hakuta407's U.S. equivalent, US 6 743 862.

For Applicants' argument (Remarks, page 8, 4th paragraph), Hakuta407 further teaches the use of a silicone oil. (col. 16, lines 54-65) Examiner takes Official Notice that a silicone oil is a polydimethylsiloxane that should have a formula falling within the scope of the claimed organosiloxane (B).

For Applicants' argument (Remarks, page 8, 5th paragraph to page 9; 3rd paragraph), Examiner is not able to find a basis in Applicants' specification that the claimed SiH group-containing compound (C) **must** be a liquid. Nonetheless, Hakuta407's Si-H group-containing compound (B) can be 1,1,3,3-tetramethyldisiloxane, etc. (col. 11, line 61 to col. 12, line 2), which is a **liquid**. Hakuta407's ethylene/ α -olefin/non-conjugated polyene random copolymer can have an intrinsic viscosity described in col. 8, lines 56-60, which **reads on** the claimed intrinsic viscosity. As such, the random copolymer can be **liquid**. *In re Best*, 195 USPQ 430 (CCPA 1977). In addition, the aforementioned silicone oil should be a **liquid**. Since the primary components are liquid, the composition should be in a liquid form. Notably, the "resulting compounded rubber" can be

casted to a metallic frame. (Example 1) As such, the composition as a whole should be in a liquid form.

For Applicants' argument (Remarks, page 12, 4th paragraph to page 13, last paragraph), the above rejection is applicable here.

4. Rejection of Claims 16-17 and 22-27 under 35 USC 103(a) as being unpatentable over Hakuta251 (WO 00/55251, US 6 864 315) is maintained because the rejection is adequately set forth in paragraph 5 of Paper No. 012007. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

The following column and line numbers are based on Hakuta251's U.S. equivalent, US 6 684 315.

For Applicants' argument (Remarks, page 9 last paragraph), Examiner apologizes for causing any confusion due to the typographical error.

For Applicants' argument (Remarks, page 10, last paragraph to page 11, 4th paragraph and page 12, 1st paragraph to 3rd paragraph), the intrinsic viscosity of the ethylene/ α -olefin/non-conjugated polyene random copolymer can be as low as 0.3 dl/g (col. 21, lines 35-54) that is very close to the claimed value of **less than** 0.3 dl/g. Furthermore, the physical state of a polymer is closely related to the

molecular weight thereof that in turn related its intrinsic viscosity. As such, Examiner has a reasonable basis to believe Hakuta251's random copolymer can be in the same state (i.e., liquid state) as that of Applicants'. Notably, Hakuta251's composition **as a whole** can be molded by **RIM** (col. 8, line 64 to col. 9, line 3 and col. 15, line 66 to col. 16, line 8) that is a typical process where a **liquid** material is processed. As such, the desirability of adjusting the viscosity of the composition is not limited to a solid composition, rather a liquid composition as well. It is noted that for any injection molding process, the viscosity of the composition must be well optimized for generating proper shear force and flowability. **Alternatively**, Applicants are reminded that a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985)

For Applicants' argument (Remarks, page 11, last paragraph), Applicants are reminded that the random copolymer can be in a **liquid** state. (col. 49, lines 54-62)

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is

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Art Unit: 1796

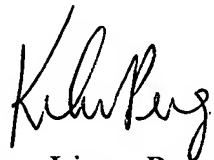
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(571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Klp
November 21, 2007


Kuo-Liang Peng
Primary Examiner
Art Unit 1796